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storytelling with data, LLC

11 STORYTELLING WITH DATA, LLC, a California limited liability company,

Plaintiff,

VS.

15 TRUSTEES OF BOSTON UNIVERSITY;
and DOES 1-50, inclusive,

Defendants.

No.

PLAINTIFF STORYTELLING WITH DATA, LLC'S COMPLAINT FOR FEDERAL TRADEMARK INFRINGEMENT, FALSE DESIGNATION OF ORIGIN, CALIFORNIA COMMON LAW TRADEMARK INFRINGEMENT, AND CALIFORNIA STATUTORY UNFAIR COMPETITION

DEMAND FOR JURY TRIAL

19 Plaintiff storytelling with data, LLC (“SWD” or “Plaintiff”), by its attorneys, for its
20 Complaint in this action alleges:

PARTIES

22 1. SWD is a California limited liability company having its principal place of
23 business in San Francisco, California.

24 2. On information and belief, the Trustees of Boston University (“Boston
25 University”) is a non-profit educational institution with its principal place of business at One
26 Silber Way, Boston, Massachusetts 02215.

27 3. SWD is ignorant of the true names of the other Defendants sued herein as Does 1–
28 50, inclusive, and therefore, sues these Doe Defendants by such fictitious names. Additional Doe

1 Defendants are likely to include, among others, any other individuals or entities that have
 2 authorized, condoned, directed, or participated in the trademark infringement alleged in this
 3 Complaint, such as any individuals at Boston University who made the decision to continue
 4 infringing SWD's STORYTELLING WITH DATA trademark after being notified of such
 5 infringement by SWD. SWD will amend this Complaint to allege their true names and capacities
 6 when ascertained.

7 **JURISDICTION AND VENUE**

8 4. This Court has subject matter jurisdiction of this action under 28 U.S.C. §§ 1331,
 9 1338(a) and (b), and 1367, 15 U.S.C. § 1121, as this action involves substantial claims arising
 10 under the U.S. Trademark Act of 1946, as amended, 15 U.S.C. § 1051 *et seq.*, combined with
 11 related and supplemental claims for state trademark infringement and unfair competition.

12 5. Defendant Boston University is subject to personal jurisdiction in this district
 13 because it conducts substantial, continuous, and systematic activities in this judicial district and
 14 because SWD's causes of action contained herein arise out of or result from Defendant's contacts
 15 with this judicial district.

16 6. Venue is proper in this judicial district pursuant to 28 U.S.C. § 1391(b) because a
 17 substantial part of the events or omissions giving rise to the claims occurred in this judicial
 18 district and SWD's intellectual property that is the subject of this action is situated in this judicial
 19 district.

20 **INTRADISTRICT ASSIGNMENT**

21 7. Pursuant to N.D. Civil Local Rule 3-2(c), this is an intellectual property action
 22 subject to district-wide assignment.

23 **FACTS RELEVANT TO ALL CLAIMS**

24 **Plaintiff's adoption, use, and ownership of the STORYTELLING WITH DATA mark**

25 8. SWD was founded by Nicole ("Cole") Nussbaumer Knafllic, a well-known author,
 26 speaker, and leading expert in the field of communication and data visualization, and Managing
 27 Member of SWD.

28 9. Ms. Nussbaumer Knafllic is the author of the popular book titled "Storytelling with

1 *Data*,” published by Wiley in 2015. The book enjoys widespread distribution with over 46,000
2 copies sold and it is a regular “#1 Best Seller” on Amazon.com across multiple categories.

3 10. In addition to her book, Ms. Nussbaumer Knaflc writes the popular “Storytelling
4 With Data” blog, established in 2010.

5 11. For more than six years, businesses, organizations and individuals have looked to
6 the Storytelling With Data® brand presentations, workshops and educational sessions as the
7 premier source of training in data visualization and communication. Since 2011, Ms.
8 Nussbaumer Knaflc and/or SWD have conducted more than 200 public and private workshops
9 under the STORYTELLING WITH DATA mark. Customers of the STORYTELLING WITH
10 DATA educational workshops, training services, and written materials include a wide range of
11 high profile businesses, including eBay, Google, General Mills, Hewlett Packard, JPMorgan
12 Chase, Microsoft, Target, Visa, and World Bank, as well as high profile educational institutions.

13 12. With regard to educational institutions, Ms. Nussbaumer Knaflc has guest
14 lectured at numerous universities and the Storytelling With Data book is utilized in the
15 curriculum of many educational institutions, including Stanford, Northwestern, University of
16 Washington, Midwestern State University, Oklahoma State University, CUNY, University of
17 North Carolina, ZHAW (Switzerland), Kellogg, Columbia, Augusta University, Pepperdine,
18 Georgetown, and the University of New Brunswick (Canada).

19 13. Through these prestigious engagements, widespread distribution of the book, blog,
20 and other educational materials, and through promotional efforts, consumers identify SWD and
21 Ms. Nussbaumer Knaflc as the source of the STORYTELLING WITH DATA educational
22 materials and services. As a result, Ms. Nussbaumer Knaflc and/or SWD own common law
23 trademark rights in the STORYTELLING WITH DATA mark dating back to at least as early as
24 December 9, 2010.

25 14. On January 27, 2016, Ms. Nussbaumer Knaflc filed federal U.S. application Serial
26 No. 86/888,258 for the STORYTELLING WITH DATA trademark with the U.S. Patent and
27 Trademark Office (“USPTO”).

28 15. On September 6, 2016, U.S. application Serial No. 86/888,258 matured into

1 federal U.S. trademark Registration No. 5,035,958 for the STORYTELLING WITH DATA
2 trademark in connection with the following goods and services: (i) electronic publications,
3 namely, articles, videos, presentations, documents and spreadsheets in the fields of business
4 communications and professional development; downloadable multimedia files containing audio
5 and video relating to business communications and professional development; video recordings
6 featuring instruction in the fields of business communications and professional development;
7 downloadable video recordings featuring instruction in the fields of business communications and
8 professional development; audio and video recordings featuring instruction in the fields of
9 business communications and professional development, in International Class 9, and (ii) on-line
10 journals, namely, blogs in the fields of business communications and professional development;
11 providing a website featuring blog posts and non-downloadable publications in the nature of
12 articles, videos, presentations, documents and spreadsheets in the fields of business
13 communications and professional development; providing on-line publications in the nature of
14 articles, videos, presentations, documents and spreadsheets in the fields of business
15 communications and professional development; educational services, namely, conducting
16 workshops, seminars, webinars, classes and providing training in the fields of business
17 communications and professional development; educational services, namely, workshops and
18 presentations in the fields of business communications and personal development and distribution
19 of training materials in connection therewith; educational services, namely, consulting and
20 coaching to improve communications, messages and presentations in the fields of business
21 communications and personal development, in International Class 41. A true and correct copy of
22 the certificate of registration is attached hereto as **Exhibit A**.

23 16. On March 7, 2017, Ms. Nussbaumer Knaflc formed and registered SWD as a
24 California limited liability with the California Secretary of State. Ms. Nussbaumer Knaflc is the
25 managing member of SWD.

26 17. On March 21, 2017, Ms. Nussbaumer Knaflc assigned all right, title, and interest
27 to the STORYTELLING WITH DATA trademark, including U.S. trademark Registration No.
28 5,035,958, along with all the goodwill of the business associated with the STORYTELLING

1 WITH DATA trademark, to SWD. The assignment was recorded at the USPTO on September 8,
 2 2017 at Real/Frame No. 6150/0839. As such, SWD now owns all common law and registered
 3 trademark rights for the STORYTELLING WITH DATA trademark.

4 **Boston University intentionally adopts the identical STORYTELLING WITH DATA mark**

5 18. Maggie Mulvihill (“Professor Mulvihill”) is an individual and faculty member at
 6 Boston University’s College of Communication. Professor Mulvihill runs the workshops at
 7 Boston University that use the infringing STORYTELLING WITH DATA mark.

8 19. In approximately March 2015, Professor Mulvihill reached out to Ms. Nussbaumer
 9 Knafllic, expressing her admiration for her STORYTELLING WITH DATA educational materials
 10 and workshops, and invited Ms. Nussbaumer Knafllic to speak to students at a Boston University
 11 workshop. Due to other commitments, Ms. Nussbaumer Knafllic politely declined the invitation.

12 20. At least by that time, Professor Mulvihill and Boston University were admittedly
 13 familiar with Ms. Nussbaumer Knafllic’s body of work and goods and services provided under the
 14 STORYTELLING WITH DATA trademark.

15 21. Despite being aware of Ms. Nussbaumer Knafllic’s prior long-standing use of the
 16 STORYTELLING WITH DATA mark for educational materials and services, and on information
 17 and belief, Boston University and Professor Mulvihill decided to adopt and use the identical
 18 STORYTELLING WITH DATA trademark to prominently promote and sell directly competing
 19 educational materials and services, including workshops.

20 22. Further exacerbating the confusion, the logos used by Boston University and SWD
 21 in connection with the STORYTELLING WITH DATA marks feature nearly identical fonts and
 22 a row of vertical bars in the center of the mark:



23
 24 <https://www.bu.edu/com/data-storytelling/>



25
 26
 27 <http://www.storytellingwithdata.com/>

1 23. More recently, Boston University has begun offering digital badges in connection
2 with its infringing STORYTELLING WITH DATA workshops, which feature the confusingly
3 similar phrase DATA STORYTELLING. These badges essentially encourage students who
4 graduate from Boston University's infringing workshops to display SWD's registered mark
5 without authorization from SWD.

6 **Boston University refuses to discontinue its willful infringement**

7 24. On January 5, 2017, shortly after discovering Defendant Boston University's
8 infringement, SWD sent a cease and desist email to Boston University notifying Boston
9 University of SWD's prior rights in the STORYTELLING WITH DATA trademark and
10 ownership of federal U.S. trademark Registration No. 5,035,958 for STORYTELLING WITH
11 DATA and requesting that Boston University discontinue its infringing use of the identical
12 STORYTELLING WITH DATA trademark.

13 25. SWD sent a follow-up email requesting a response in light of the confusion being
14 created by Boston University's infringing use of the identical STORYTELLING WITH DATA
15 trademark.

16 26. On February 13, 2017, Boston University's Associate General Counsel, Sheila
17 O'Leary, acknowledged receipt of SWD's January 5, 2017 cease and desist email and indicated
18 that she would send "a substantive response shortly, under separate cover."

19 27. On March 6, 2017, SWD still had not received a response from Boston University
20 or Ms. O'Leary and followed up with yet another email.

21 28. Finally, over two months later on March 17, 2017, Boston University, through Ms.
22 O'Leary, responded to SWD's January 5, 2017 email. Despite its clear trademark use of
23 STORYTELLING WITH DATA, Boston University unconvincingly denied that it was infringing
24 at least partly on the grounds that it was only using the STORYTELLING WITH DATA mark to
25 describe its services.

26 29. On April 17, 2017, SWD, through its counsel Carr & Ferrell LLP, sent a letter to
27 Boston University substantively responding to Ms. O'Leary's March 17, 2017 letter. The letter
28 detailed SWD's prior rights in the STORYTELLING WITH DATA trademark, Boston

1 University's intentional, bad faith adoption of the identical mark and similar logo, and reiterated
 2 SWD's request that Boston University cease its infringement. The letter requested a response by
 3 May 1, 2017.

4 30. Despite requesting a response by May 1, 2017, Boston University did not respond,
 5 forcing SWD's counsel to contact and follow-up with Ms. O'Leary regarding the matter.

6 31. On June 5, 2017 Ms. O'Leary finally sent a brief email reply, and on June 8, 2017,
 7 she made herself available for an initial telephone call with SWD's counsel. However, Boston
 8 University was unwilling to discontinue its infringing use of STORYTELLING WITH DATA.

9 32. Finally, after multiple requests to discuss the matter, on August 28, 2017, Ms.
 10 O'Leary had a second telephone call with SWD's counsel. However, again, Boston University
 11 was unwilling to discontinue its infringing use of STORYTELLING WITH DATA.

12 33. On August 31, 2017, Ms. O'Leary sent an email to SWD's counsel restating the
 13 University's position on that matter and refusing to discontinue its infringing use of the identical
 14 STORYTELLING WITH DATA trademark, thereby leaving SWD with no recourse but to file
 15 the instant Complaint for trademark infringement.

16 **Boston University's infringing use of the STORYTELLING WITH DATA has created and**
 17 **continues to create a likelihood of confusion among the public**

18 34. Notwithstanding Defendant Boston University's knowledge of SWD's prior rights
 19 in the STORYTELLING WITH DATA trademark, Boston University has and is promoting its
 20 competing educational materials and services, including workshops, under the identical and
 21 confusingly similar STORYTELLING WITH DATA trademark in Massachusetts, California, and
 22 throughout the United States with the deliberate and calculated intent to trade on the goodwill and
 23 reputation symbolized by SWD's STORYTELLING WITH DATA mark to confuse and mislead
 24 the public.

25 35. Defendant Boston University's use of the identical STORYTELLING WITH
 26 DATA trademark is likely to cause confusion, cause mistake, and/or deceive consumers and the
 27 purchasing public as to affiliation, connection, or association of SWD and Boston University and
 28 as to origin, sponsorship, or approval of Boston University's services by SWD.

FIRST CLAIM FOR RELIEF
INFRINGEMENT OF A REGISTERED TRADEMARK
UNDER § 32(1) OF THE LANHAM ACT (15 U.S.C. § 1114(1))

36. Paragraphs 1–35, above, are realleged and incorporated by reference as if set forth in full.

37. Plaintiff SWD owns prior rights in the STORYTELLING WITH DATA trademark and owns federal U.S. trademark Registration No. 5,035,958 for the STORYTELLING WITH DATA trademark in connection with the educational goods and services listed in Exhibit A.

38. By virtue of the registered status of SWD's STORYTELLING WITH DATA trademark, Defendant Boston University had constructive notice of SWD's rights in the mark. By acting with such notice and knowledge, Boston University has willfully and deliberately infringed SWD's trademark rights.

39. Boston University's use of the identical STORYTELLING WITH DATA trademark in connection with highly similar, if not identical, services, namely, educational materials and workshops is likely to cause confusion, cause mistake, and/or deceive consumers and the purchasing public as to affiliation, connection, or association of SWD and Boston University and as to origin, sponsorship, or approval of Boston University's services by SWD. In addition, Boston University's infringement is likely to cause, *inter alia*, subliminal and associational confusion, forward confusion, reverse confusion, initial interest confusion, point-of-sale confusion, and post-sale confusion.

40. Defendant Boston University's aforesaid acts have caused and will continue to cause SWD to suffer damages and irreparable injury, and unless such acts are restrained by this Court through a temporary restraining order, preliminary injunction, and/or permanent injunction, such acts will be continued and SWD will continue to suffer damages and irreparable injury.

SECOND CLAIM FOR RELIEF
FALSE DESIGNATION OF ORIGIN
UNDER § 43(a) OF THE LANHAM ACT (15 U.S.C. § 1125(a))

41. Paragraphs 1–40, above, are realleged and incorporated by reference as if set forth in full.

1 42. SWD owns common law trademark rights in the STORYTELLING WITH DATA
2 trademark and STORYTELLING WITH DATA Design Mark (collectively the
3 "STORYTELLING WITH DATA Marks") in connection with a variety of educational
4 publications and materials and a variety of educational services.

5 43. SWD's trademark rights in the STORYTELLING WITH DATA Marks predate
6 any trademark use by Boston University of the infringing identical STORYTELLING WITH
7 DATA trademark. More specifically, SWD's first use of the STORYTELLING WITH DATA
8 Marks occurred at least as early as December 9, 2010.

9 44. Boston University's use of the identical STORYTELLING WITH DATA
10 trademark in connection with highly similar, if not identical, services, namely, educational
11 materials and workshops is likely to cause confusion, cause mistake, and/or deceive consumers
12 and the purchasing public as to affiliation, connection, or association of SWD and Boston
13 University and as to origin, sponsorship, or approval of Boston University's services by SWD. In
14 addition, Boston University's infringement is likely to cause, *inter alia*, subliminal and
15 associational confusion, forward confusion, reverse confusion, initial interest confusion, point-of-
16 sale confusion, and post-sale confusion.

17 45. Defendant Boston University's aforesaid acts have caused and will continue to
18 cause SWD to suffer damages and irreparable injury, and unless such acts are restrained by this
19 Court through a temporary restraining order, preliminary injunction, and/or permanent injunction,
20 such acts will be continued and SWD will continue to suffer damages and irreparable injury.

THIRD CLAIM FOR RELIEF
TRADEMARK INFRINGEMENT
UNDER CALIFORNIA COMMON LAW

24 46. Paragraphs 1–45, above, are realleged and incorporated by reference as if set forth
25 in full.

26 47. SWD owns common law trademark rights in the STORYTELLING WITH DATA
27 trademark and STORYTELLING WITH DATA Design Mark (collectively the
28 "STORYTELLING WITH DATA Marks") in connection with a variety of educational

1 publications and materials and a variety of educational services.

2 48. SWD's trademark rights in the STORYTELLING WITH DATA Marks predate
 3 any trademark use by Boston University of the infringing identical STORYTELLING WITH
 4 DATA trademark. More specifically, SWD's first use of the STORYTELLING WITH DATA
 5 Marks occurred at least as early as December 9, 2010.

6 49. Boston University's use of the identical STORYTELLING WITH DATA
 7 trademark in connection with highly similar, if not identical, services, namely, educational
 8 materials and workshops is likely to cause confusion, cause mistake, and/or deceive consumers
 9 and the purchasing public as to affiliation, connection, or association of SWD and Boston
 10 University and as to origin, sponsorship, or approval of Boston University's services by SWD. In
 11 addition, Boston University's infringement is likely to cause, *inter alia*, subliminal and
 12 associational confusion, forward confusion, reverse confusion, initial interest confusion, point-of-
 13 sale confusion, and post-sale confusion.

14 50. Defendant Boston University's aforesaid acts have caused and will continue to
 15 cause SWD to suffer damages and irreparable injury, and unless such acts are restrained by this
 16 Court through a temporary restraining order, preliminary injunction, and/or permanent injunction,
 17 such acts will be continued and SWD will continue to suffer damages and irreparable injury.

18 51. Defendant Boston University acted with malice, oppression, and fraud, as defined
 19 in California Civil Code § 3294, and willfully and with the intent to cause injury to SWD, thereby
 20 warranting an assessment of punitive damages in an amount appropriate to punish Defendant and
 21 to deter others from engaging in similar conduct.

22

23 **FOURTH CLAIM FOR RELIEF**
 24 **STATUTORY UNFAIR COMPETITION**
UNDER CALIFORNIA BUSINESS & PROFESSIONS CODE § 17200 *et seq.*

25 52. Paragraphs 1–51, above, are realleged and incorporated by reference as if set forth
 26 in full.

27 53. As detailed throughout this Complaint and in Paragraphs 38-40 above, Defendant
 28 Boston University has infringed SWD's STORYTELLING WITH DATA trademark by using the

1 identical STORYTELLING WITH DATA trademark in connection with highly similar, if not
2 identical, goods and services. Defendant's acts and conduct constitute "unlawful, unfair, or
3 fraudulent business act[s] or practice[s] and unfair, deceptive, untrue, or misleading advertising"
4 within the meaning of California Business and Professions Code §17200 *et seq.* Defendant's acts
5 and conduct are wrongful, knowing, willing, and malicious, and constitute unfair competition
6 under California law.

7 54. Defendant Boston University's aforesaid acts have caused and will continue to
8 cause SWD to suffer damages and irreparable injury, and unless such acts are restrained by this
9 Court through a temporary restraining order, preliminary injunction, and/or permanent injunction,
10 such acts will be continued and SWD will continue to suffer damages and irreparable injury.

11 55. Defendant Boston University acted with malice, oppression, and fraud, as defined
12 in California Civil Code § 3294, and willfully and with the intent to cause injury to SWD, thereby
13 warranting an assessment of punitive damages in an amount appropriate to punish Defendant and
14 to deter others from engaging in similar conduct.

PRAYER FOR RELIEF

16 WHEREFORE, SWD prays for judgment against Defendant Boston University and relief
17 as follows:

18 (i) that pursuant to 15 U.S.C. § 1116 and its inherent equitable powers, the Court
19 issue a temporary restraining order, preliminary injunction, and permanent injunction restraining
20 and enjoining Defendant Boston University from using the STORYTELLING WITH DATA
21 mark in connection with educational materials and services, as well as any names or marks
22 confusingly similar to SWD's STORYTELLING WITH DATA trademark, including any marks
23 consisting of or containing both the terms STORYTELLING and DATA;

24 (ii) that Defendant Boston University be ordered to remove and/or deliver up for
25 destruction all advertisements, packaging, labels, materials, and other articles bearing the
26 STORYTELLING WITH DATA mark, as well as any marks that infringe SWD's
27 STORYTELLING WITH DATA trademark, including any marks consisting of or containing
28 both the terms STORYTELLING and DATA;

(iii) that pursuant to 15 U.S.C. § 1117(a), SWD recover Defendant Boston University's profits and such sums in addition thereto as the Court shall find just;

(iv) that pursuant to 15 U.S.C. § 1117(a), SWD recover the damages sustained in an amount to be proven at trial;

(v) that pursuant to 15 U.S.C. § 1117(a), SWD recover the costs of this action, including reasonable attorneys' fees and interest;

(vi) that pursuant to California Business & Professions Code § 17200 *et seq.*, SWD be awarded restitution;

(vii) that pursuant to California Civil Code § 3294, the Court award punitive damages against Defendant Boston University;

(viii) that the Court declare that Defendant Boston University's use of the STORYTELLING WITH DATA mark in connection with educational materials and services infringes SWD's trademark rights in the STORYTELLING WITH DATA mark;

(ix) that SWD be awarded its costs and attorneys' fees; and

(x) such other and further relief that this Court may deem just and equitable.

Dated: October 9, 2017

Respectfully submitted,

CARR FERRELL LLP

By Robert J. Yorio
Robert J. Yorio
Attorneys for Plaintiff
storytelling with data, LLC

DEMAND FOR JURY TRIAL

Pursuant to Rule 38 of the Federal Rules of Civil Procedure, Plaintiff demands a jury trial.

Dated: October 9, 2017

Respectfully submitted,

CARR FERRELL LLP

By Robert J. Yorio
Robert J. Yorio
Attorneys for Plaintiff
storytelling with data, LLC